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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,701	10/05/2005	Fabiano Minelli	1542-2 PCT/US	8740
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HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
			3679	
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			01/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,701

Applicant(s)

MINELLI, FABIANO

Examiner

Victor MacArthur

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 9 is objected to because of the following informalities:

- The preamble of Claim 1 functionally recites the limitation “for fixing panels comprising: a first and at least a second panel... each including an end bar” (lines 1-3 of claim 1) such that the “fixing panels”, “first and at least a second panel”, “end bar” and “another like end bar” do not constitute positively recited structure but rather elements only **intended to be used** with the “fixing system” (line 1 of claim 1). However, the claims elsewhere (e.g., line 6 of claim 9 “said slit having a width at least equal to the width of said end bars) positively recite the above-mentioned structure thus creating a confusing ambiguity. The applicant should amend the claims to consistently recite the intended use structure functionally throughout. If the applicant actually intends for the above-mentioned structure to positively limit the scope of the claims then the intended use terminology “for” (line 1 of claim 9) must be omitted. For purposes of examination, the examiner has considered the claims without combination. See MPEP 2111.02 and *Kropa v. Robie*, 88 USPQ at 480-481; *Rowe*, 42 USPQ2d at 1553; and *IMS Technology Inc. v. Haas Automation Inc.*, 54 USPQ2d 1129, 1137 (Fed.Cir.2000).

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as follows:

- It is unclear if the connecting bolt and nut of lines 4-7 of claim 9 are meant to further limit the “fixing system” (line 1 of claim 9) or the “attaching panels” (line 1 of claim 9) that are merely intended to be used with the fixing system. Currently, claim 9 does not specifically state that the “fixing system” comprises any specific structure at all. Note that only the “attaching panels” are limited to “comprising” (line 1 of claim 9) any specific structure.
- The phrase “like” appears in line 3 of claim 9. The addition of the word “like” to an otherwise definite expression extends the scope of the expression so as to render it indefinite. It is unclear what the word “like” is intended to convey. See MPEP § 2173.05(b).
- It is unclear how the phraseology “said slit having a width at least equal to the width of said end bars” (line 6 of claim 9) is meant to limit the claim since the “end bars” have been previously set forth as mere intended use. See claim objections above.
- The phraseology “The fixing system of Claim 9, **further** comprising” (line 1 of claim 10) is unclear since the “fixing system” has not been previously set forth as

comprising anything. Note that only the “attaching panels” (line 1 of claim 1) are previously set forth as “comprising” any structure.

- It is unclear if the limitation “further comprising at least one pole” (line 1 of claim 10) is comprised within the fixing system or the intended use attaching panels. For purposes of rejection under prior art the examiner assumes the pole to be comprised within the intended use panels since the “fixing system” is not previously recited as comprising anything (see bullet statement above).

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the claim scope. The applicant is strongly urged to amend the entirety of the claims (not only the examples listed above) to conform to current U.S. practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fricke (U.S. Patent 834,669).

Fricke appears to disclose all of the applicants elected claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2nd paragraph rejections above) to include a

fixing system (fig.9) including a connector bolt (8a, 2a) having a threaded stem (8a) provided with a longitudinal through slit (11) and a nut (10). The Fricke fixing system is fully capable of performing all of the applicant's intended use limitations (e.g., with panels, end bars, poles, transversal plates and aligned holes) since the Fricke fixing system bolt and nut structure is identical to all of applicant's claimed structure and therefore equally inherently capable of such usage. See MPEP 2112.01.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that Fricke does not disclose a screw with a slit in the threaded stem that partly extends in the head since the Fricke groove at 5a cannot be interpreted as a slit. This is not persuasive. The Fricke groove at 5a as shown in figure 9 is a slit in as much as applicant's own invention is. Furthermore, applicant's slit forms a groove in as much as Fricke does. Applicant's argument amounts to a mere disagreement in preferred nomenclature. Applicant is reminded that where there is physical identity between the subject matter of the claim and the prior art, the label given to the claimed subject matter does not distinguish the invention over the prior art. In re Pearson, 494 F. 2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Lemin, 326 F. 2d 437, 140 USPQ 273 (CCPA 1964).

Applicant argues that the claimed intended use differs from that of Fricke. This is not persuasive since applicant's claims are drawn to a product invention. MPEP 2112.01 clearly states that in a product claim "when the structure recited in the reference is substantially identical

to that of the claims, claimed properties or functions are presumed to be inherent". The burden to provide evidence proving that the prior art structure is incapable of performing the claimed function is properly shifted to the applicant, since the PTO is unable to manufacture products or to obtain and compare prior art products. Merely arguing that the prior art structure cannot perform the claimed function and/or describing scenarios in which the prior art might not perform the claimed function is not considered proper evidence but rather mere allegation. In re Swinehart, 439 F.2d 210, 212-213, 169 USPQ 226, 229 (CCPA 1971); In re Best, 562 F.2d 1252, 195 USPQ 430 (1977); In re Schreiber, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997). As of yet applicant has failed to provide any proper evidence proving that the prior art structure is incapable of performing the applicant's functional limitations.

Lastly, it should be noted that if applicant amends the claims to positively require the combination, the drawings must be amended to show ALL of the positively recited structure. Note that currently the intended use "pair of aligned holes" (lines 1-2 of claim 12) is not shown in the drawings.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Application/Control Number:
10/532,701
Art Unit: 3679

Page 7

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



VLM
January 8, 2008



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600